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PATENT APPLICATIONATTORNEY DOCKET NO. 10003223-1

Inventor(s): **Mark A. Harper et al.**
Application No.: **09/665,349**
Filing Date: **September 18, 2000**

Confirmation No.: **4554**Examiner: **Maria Teresa T. Thein**
Group Art Unit: **3627****Title: Localizing Client Purchasing of Consumables for Output Engine and Method**

Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

Response/Amendment
 New fee as calculated below
 No additional fee
 Other Reply Brief

Petition to extend time to respond
 Supplemental Declaration

Fee\$

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$210	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM + \$370 \$ 0						
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$460	<input type="checkbox"/> 3rd Month \$1050	<input type="checkbox"/> 4th Month \$1640		\$ 0
OTHER FEES \$						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT \$ 0						

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

 A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Mark A. Harper et al.

By



James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No. : 39,833

Date : 12/3/07

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Signature:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/665,349
 Filing Date.....September 18, 2000
 Inventor.....Mark A. Harper et al.
 Assignee.....Hewlett-Packard Development Company, L.P.
 Group Art Unit 3627
 Examiner.....Maria Teresa T. Thein
 Attorney's Docket No. PDNO. 10003223-1
 Confirmation No.....4554
 Title: Localizing Client Purchasing of Consumables for Output Engine and Method

REPLY BRIEF

To: Mail Stop Appeal Brief-Patents
 Commissioner of Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
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Appellant respectfully asserts the rejections set forth in the Office Action dated June 1, 2005 (hereinafter "Office Action" or "Action") are deficient for the reasons set forth in the Brief of Appellant (hereinafter "Brief") and the reasons herein. Appellant respectfully requests reversal of the rejections of the claims.

Argument A

Claims 1-7, 23-25, 28 and 32-33 recite *determining an electronic address for a consumable supplier or vendor appropriate to a geographical area in which the hard copy output engine is to be deployed.*

Appellant notes that, in the Office Action, the Office relied upon teachings in cols. 8, 9 and 11 of Beard as allegedly teaching the above-recited limitations. In the Response to Argument section of the Examiner's Answer (hereinafter "Answer"), the Office relies upon the teachings in cols. 7-9 of Beard as allegedly

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teaching the above-recited limitations. Appellants respectfully submit that the teachings of col. 11 of Beard fail to teach the above-recited limitations for the reasons set forth in the Brief and the teachings of cols. 7-9 of Beard fail to teach the above-recited limitations for the reasons set forth in the Brief and herein. In particular, the teachings of Beard relied upon by the Office fail to disclose or suggest the claimed limitations reciting *determination of the electronic address for a consumable supplier or vendor appropriate to a geographical area in which the engine is deployed.*

Referring to page 15 of the Answer, the Office recites various teachings regarding functionality of the CRUM of Beard as teaching the above-recited limitations. However, col. 8, lines 30+ of Beard explicitly provide that the CRUMs store various data including: for a Service Plan data type - a code which could instruct the board 30 to send a request to recorder new modules to a manufacturer; for a Market Region data type - another code which identifies the module as belonging to a particular market region; for a Print Count data type - a number of prints which have been created; and for a Maximum Print Volume Value data type - a number of the maximum rated number of prints for the module. The operations of the CRUM including storing various information void of mentioning storage of an electronic address fails to teach or suggest determining an electronic address for a consumable supplier or vendor appropriate to a geographical area in which the hard copy output engine is to be deployed as positively claimed. Appellant respectfully submits the 102 rejection is in error for at least this reason.

Beard teaches sending a message to a manufacturer or supplier when a new module is needed to be re-ordered per col. 8, lines 30+ and col. 9, lines 9+. However, there is no teaching in Beard that the manufacturer or supplier which receives the communication is appropriate to the geographical area within which the hard copy output engine is to be deployed. Accordingly, the teachings of Beard regarding the sending of a request to re-order a module to the manufacturer or supplier may not be fairly considered to teach or suggest the above-recited claim limitations of *determining an electronic address for a consumable supplier or vendor appropriate to a geographical area within which the hard copy output engine is to be deployed*. Since Beard is void of any teachings of sending the request to a manufacturer or supplier appropriate to the geographical area within which the

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copying apparatus will be deployed, Appellant respectfully submits there is no teaching or suggestion in Beard of determining an electronic address for a manufacturer or supplier appropriate to the geographical area within which the hard copy engine is to be deployed. The disclosed arrangements of Beard have no use for such an electronic address and Appellants respectfully submit it is non-sensical to determine such an address in the arrangement of Beard.

Referring to page 14 of the Answer, the Office relies upon the teachings of col. 8, lines 29+ of Beard which are disclosed as being one type of data (per col. 8, line 9) of a "Service Plan" which provides that the device sends a request to reorder new modules to the manufacturer. The Office also relies upon teachings in col. 8, lines 44+ of Beard which are disclosed as being part of a different type of data of a "Market Region" which provides that the CRUM contains information regarding a geographical area in which the device will be used *to prevent inappropriate modules from being used in the device and which may damage the device if used* (e.g., use of a US module designed for 110V in a copying device used in Europe designed for 220V in the disclosed example). Appellants have failed to uncover any association in Beard of the disparate teachings regarding the Market Region and the Service Plan. In particular, Appellants have failed to uncover any teachings in Beard that the geographical information of the Market Region for preventing damage to the copying apparatus is used to place a request for a module in the Service Plan. The use of geographical information in Beard to *prevent use of an inappropriate module in the copying apparatus and having no disclosed relationship to the communications of the module ordering functions of Beard* may not be fairly interpreted to teach or suggest the positively claimed limitations of *determining an electronic address for a consumable supplier or vendor appropriate to a geographical area within which the hard copy output engine is to be deployed* as positively claimed.

Appellant also respectfully submits that reliance upon inherency in support of the rejection is improper. In particular, referring to pages 15-17 of the Answer, the Office states that it is inherent that an electronic address is used in Beard to communicate with a manufacturer and to send a request to re-order new modules. The Office cites dictionary definitions of token and token ring network in support of the reliance upon inherency. However, Appellant notes that the Answer fails to

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address the additional communication alternative in the Brief where a remote device would poll the copying apparatus of Beard to receive the request for the new module from the copying apparatus. Appellant respectfully submits that the reliance upon inherency is improper in view of the presence of alternatives to the claimed electronic address.

Regardless, even if the use of an electronic address is considered to be inherent to request a module in Beard, there is no teaching or suggestion to determine an electronic address appropriate to the geographical area within which the engine will be deployed. Beard provides no association or relationship of the geographical information which is disclosed to prevent use of an inappropriate module in the copying apparatus with the communications of the module ordering functions of Beard. Accordingly, Appellant respectfully submits that the claimed limitations of determining an electronic address for a consumable supplier appropriate to the geographical area within which the hard copy output engine is to be deployed is not disclosed nor suggested by Beard and such limitations may not be fairly considered to be inherent for the above compelling reasons.

Appellant respectfully submits that positively defined limitations of the claims are not disclosed by the prior art for the reasons set forth in the Brief and herein, and Appellant respectfully requests reversal of the 102 rejection of the claims.

Argument B

Claims 1-7, 23-25, 28, and 32-33 recite *programming or storing an electronic address for a consumables supplier or vendor appropriate to a geographical area within which a hard copy output engine is to be deployed in memory of the hard copy output engine*.

Referring to page 19 of the Answer, the Office recites various teachings regarding functionality of the CRUM of Beard as teaching the above-recited limitations. However, col. 8, lines 30+ of Beard explicitly provide that the CRUMs store various data including: for a Service Plan data type - a code which could instruct the board 30 to send the request to recorder new modules to the manufacture; for a Market Region data type – another code which identifies the module as belonging to a particular market region; for a Print Count data type – a number of prints which have been created; and for a Maximum Print Volume Value

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data type – a number of the maximum rated number of prints for the module. These teachings including storage of the code for instructing the board to send the request fails to teach or suggest *programming or storing an electronic address for a consumables supplier or vendor in memory of the hard copy output engine* as positively claimed. Appellant respectfully submits the 102 rejection is in error for at least this reason.

In addition, Appellant respectfully submits that the reliance upon inherency to teach the above-recited limitations is improper. For example, the copying apparatus of Beard could be polled from a remote device associated with the manufacturer to pull the request for a new module from the copying apparatus. In this one at least one suitable alternative, there is no need for an electronic address associated with the remote device to be programmed into memory of the copying apparatus. The existence of this suitable alternative illustrates that the claimed limitations of programming or storing the electronic address in memory of the hard copy output engine are not inherent.

Furthermore, even if the storage of an electronic address within the copying apparatus of Beard is considered to be inherent in the teachings of Beard, there is no teaching in Beard that the manufacturer or supplier which receives the request from the copying apparatus is appropriate for the geographical area within which the copying apparatus is to be deployed. Accordingly, Appellant respectfully submits that it is non-sensical to program or store such an electronic address in the copying apparatus of Beard since such an address has not been disclosed to be of any use in the arrangement of Beard.

Appellant respectfully submits that positively defined limitations of the claims are not disclosed by the prior art for the reasons set forth in the Brief and herein, and Appellant respectfully requests reversal of the 102 rejection of the claims.

Argument C

Claims 8-14, 15-20, 22, 26-27, 29 and 30-31 recite *extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine in combination with initiating and directly communicating with a vendor using the electronic address* (claim 8 and dependents thereof) or

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communicating with a supplier of consumables using the electronic address (claim 15 and dependents thereof).

In the Office Action, the Office relied upon the teachings in col. 12, lines 23-29 of Beard as allegedly disclosing the claimed extracting the electronic address for a vendor or supplier of a consumable from memory. The Office does not rely upon such teachings in the Response to Argument section of the Answer. Appellant respectfully submits that the teachings of col. 12 of Beard fail to teach the claimed extracting for the reasons set forth in the Brief and the reliance by the Office upon new teachings in the Response to Argument section of the Answer.

Referring to page 22 of the Answer, the Office recites various teachings regarding functionality of the CRUM of Beard as teaching the extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine as defined in the claims. Col. 8, lines 30+ of Beard explicitly provide that the CRUMs store various data including: for a Service Plan data type - a code which could instruct the board 30 to send the request to recorder new modules to the manufacture; for a Market Region data type – another code which identifies the module as belonging to a particular market region; for a Print Count data type – a number of prints which have been created; and for a Maximum Print Volume Value data type – a number of the maximum rated number of prints for the module. The storage of the above-mentioned codes and data regarding numbers of prints fails to teach or suggest *extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine* as positively claimed.

In addition, Appellant respectfully submits that the claimed extracting is not inherent from the teachings of Beard and the 102 rejection is in error for at least this reason. More specifically, other possible arrangements for communicating the request from the copying apparatus to the manufacturer or supplier exist apart from extracting an electronic address for a vendor or supplier of a consumable from memory included in the hard copy output engine as claimed. For example, the manufacturer might poll the copying apparatus to pull the request from the copying apparatus without extraction of an electronic address from the memory of the copying apparatus. Appellant respectfully submits that the claimed extracting does not necessarily flow from the teachings of Beard since suitable alternatives are

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present and the reliance upon inherency is improper under the authority set forth in the Brief regarding inherency. Appellant respectfully submits that the 102 rejection of the claims is improper for at least this reason.

In the Office Action, the Office relied upon the teachings of col. 12 of Beard as allegedly teaching the claimed *initiating and directly communicating with a vendor using the electronic address or communicating with a supplier of consumables using the electronic address*. The Office does not rely upon such teachings in the Response to Argument section of the Answer. Appellant respectfully submits that the teachings of col. 12 of Beard fail to teach the above-recited claim limitations for the reasons in the Brief and the reliance by the Office upon different teachings of Beard in the Response to Argument section of the Answer.

Furthermore, referring again to page 22 of the Answer, the teachings regarding the CRUMs storing the above-mentioned codes and data regarding numbers of prints void of any teachings regarding an electronic address fails to teach or suggest communicating with a vendor or supplier of consumables using an electronic address which was extracted from memory as positively claimed.

Additionally, at least one alternative exists in the above-described polling arrangement wherein a manufacturer may poll the copying apparatus of Beard to retrieve the request and accordingly the limitations of *initiating and directly communicating with a vendor using the electronic address or communicating with a supplier of consumables using the electronic address* may not be fairly considered to be inherent from the teachings of Beard.

Appellant respectfully submits that positively defined limitations of the claims are not disclosed by the prior art for the reasons set forth in the Brief and herein, and Appellant respectfully requests reversal of the 102 rejection of the claims.

Argument D

Referring to the 103 rejection of claim 5 over Himmel in combination with Beard, Appellant respectfully submits that the Office has failed to provide a proper articulated reasoning with a rational underpinning for combining the references as required by the Supreme Court in *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740, 82

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USPQ2d 1385, 1396 (2007). Appellant respectfully submits that the Office has failed to meet their burden of establishing a proper 103 rejection for at least this reason.

The Office, at page 23 of the Answer, and mirroring the rationale provided in the Office Action, states that the motivation for combining the references is to provide updated bookmarks (collections of URLs) in an easy and automatic way. However, the Office fails to provide a proper rational underpinning to support the cursory rationale for the combination. In particular, there is no evidence of record that, even if the references are combined, that the resultant system would provide any improvements. The record is void of any evidence that the teachings of Himmel would provide updated bookmarks in an easy and automatic way if applied to the disparate copying apparatus arrangement of Beard.

Appellant respectfully submits that the Office has failed to provide a proper articulated reasoning with sufficient rational underpinning in support of the combination of Himmel and Beard. Appellant respectfully submits that the Office has failed to meet its burden of establishing a proper 103 rejection under *KSR* for at least these reasons and Appellant respectfully requests reversal of the 103 rejection.

Argument E

Referring to the 103 rejections of claims 2-3, 7, 9, 10, 16 and 20 over Dent in combination with Beard, Appellant respectfully submits that the Office has failed to provide a proper articulated reasoning with a rational underpinning for combining the teachings of Dent and Beard as required by the U.S. Supreme Court in *KSR*. Appellant respectfully submits that the Office has failed to meet their burden of establishing a proper 103 rejection for at least this reason.

At page 25 of the Answer, the Office relies upon the same rationale for combining the prior art teachings as relied upon in the Office Action. Namely, the Office states that the rationale is to establish communications with a remotely located service provider via a network. Appellant respectfully submits that the rationale provided by the Office does not have a sufficient rational underpinning inasmuch as Beard already discloses numerous methods of communicating with a remote device over a network or telephone line (see e.g., col. 8, lines 30+ where the copying apparatus of Beard *sends a request through a network or over a phone*

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line to a manufacturer). Appellant respectfully submits that the Office has provided no evidentiary basis as to why one of ordinary skill in the art would look to modify the teachings of Beard when Beard already discloses the teachings for which Dent is provided. There is no evidentiary support that the resultant system of the combination for communicating with a device has any improvements over the copying apparatus arrangement of Beard already configured to communicate with a remote device via a network or phone line. Appellant respectfully submits that one of ordinary skill in the art would not be motivated to look to combining the teachings of Dent with the teachings of Beard since Beard already teaches plural methods of the copying apparatus of Beard providing communications with a remote device via a network.

Accordingly, Appellant respectfully submits that the Office has failed to provide a proper articulated reasoning with a sufficient rational underpinning for combining Dent with Beard. Appellant respectfully submits that the Office has failed to meet its burden of establishing a proper 103 rejection under *KSR* for at least these reasons and Appellant respectfully requests reversal of the 103 rejection.

Argument F

Claims 10 and 16 recite *extracting a universal resource locator for a consumables supplier or vendor appropriate to a geographical area within which the hard copy output engine is deployed*. At page 28 of the Answer, the Office relies upon the teachings of col. 4, line 18 of Dent as allegedly disclosing the above-recited limitations which are the same limitations relied upon by the Office in the Office Action in support of the rejection. Appellants respectfully submit that these limitations are not disclosed nor suggested by the teachings of Beard and Dent even if the references are combined and the 103 rejection is improper for at least this reason.

Beard is void of disclosing or suggesting communications to a vendor or supplier *appropriate to a geographical area within which the hard copy output engine is deployed* as positively claimed. The only geographical teachings in Beard relied upon by the Office refer to a code which designates the area of use of the copying apparatus and is disclosed as being used to confirm that the replacement

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modules which are used in the copying apparatus match the geographical location of the copying apparatus to prevent damage, for example, resulting from improper matching of voltages (110V in the U.S. versus 220V in Europe). Beard fails to disclose or suggest that the geographical code of the Market Region data type of information stored in the CRUM provides any function, has any relationship or is used in any fashion with the communications of the disparate Service Plan data type (col. 8, lines 30+) or the Maximum Print Volume Value data type (col. 9, lines 8+) which send the request to the manufacturer to request a new module. Beard fails to teach or suggest the claimed limitation of *extracting a universal resource locator for a consumables supplier or vendor appropriate to a geographical area within which the hard copy output engine is to be deployed.*

Furthermore, the teachings of Dent, even if combined with Beard, fail to cure this deficiency of Beard. In particular, Appellant has electronically searched Dent and failed to uncover any reference therein to geography or a geographical area within which a device is deployed. Accordingly, even if Dent is combined with the teachings of Beard, the combination fails to teach or suggest the claimed limitations of *extracting a universal resource locator for a consumables supplier or vendor appropriate to a geographical area within which the hard copy output engine is deployed.*

The above-recited limitations of the claims are not disclosed by the prior art references taken alone nor in combination for the reasons set forth in the Brief and herein, and Appellant respectfully requests reversal of the 103 rejection of the claims.

Conclusion

Reversal of the rejections of the claims and allowance of the claims is respectfully requested for at least the reasons discussed herein and the reasons set forth in the Brief of Appellant.

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Respectfully submitted,

Date: 12/3/07

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